



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

NOTICE OF ALLOWANCE AND ISSUE FEE DUE

HM22/0830

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| APPLICATION NO. | FILING DATE | TOTAL CLAIMS | EXAMINER AND GROUP ART UNIT | DATE MAILED |
|-----------------------|--|--------------|-----------------------------|---------------|
| 07/985,742 | 12/04/92 | 015 | FOX, D | 1649 08/30/99 |
| First Named Applicant | COMAI, 35 USC 154(b) term ext. = 0 Days. | | | |

TITLE OF INVENTION FIGWORT MOSAIC VIRUS PROMOTER AND USES (AS AMENDED)

| ATTY'S DOCKET NO. | CLASS-SUBCLASS | BATCH NO. | APPLN. TYPE | SMALL ENTITY | FEE DUE | DATE DUE |
|-------------------|----------------|-------------|-------------|--------------|--------------|----------|
| 1 | CGNE-62-1(1) | 800-278.000 | A72 | UTILITY | YES \$605.00 | 11/30/99 |

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.

THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.

HOW TO RESPOND TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.
If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown above and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

- II. Part B-Issue Fee Transmittal should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B Issue Fee Transmittal should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "4b" of Part B-Issue Fee Transmittal should be completed and an extra copy of the form should be submitted.
- III. All communications regarding this application must give application number and batch number.
Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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|-----------------------------|-------------------------|-------------------------------|-------------------------------------|
| SERIAL NUMBER 07/985,742 | FILING DATE 12/04/92 | FIRST NAMED APPLICANT COMA | ATTORNEY DOCKET NO. CGNE-62-1(1) |
|-----------------------------|-------------------------|-------------------------------|-------------------------------------|

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EXAMINER

FOX, D

ART UNIT

1649

PAPER NUMBER

42

08/30/99

DATE MAILED:

NOTICE OF ALLOWABILITY

PART I.

- ☒ This communication is responsive to papers filed 8/19/99
- ☒ All the claims being allowable. PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice Of Allowance And Issue Fee Due or other appropriate communication will be sent in due course.
- ☒ The allowed claims are 20, 22-28, 30, 33-36, 43-44 renumbered 1-8, 10-14, 9, 15
- ☐ The drawings filed on _____ are acceptable.
- ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received. ☐ not been received. ☐ been filed in parent application Serial No. _____, filed on _____.
- ☐ Note the attached Examiner's Amendment.
- ☒ Note the attached Examiner Interview Summary Record, PTOL-413.
- ☒ Note the attached Examiner's Statement of Reasons for Allowance.
- ☐ Note the attached NOTICE OF REFERENCES CITED, PTO-892.
- ☒ Note the attached INFORMATION DISCLOSURE CITATION, PTO-1449.

PART II.

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE THREE MONTHS FROM THE "DATE MAILED" indicated on this form. Failure to timely comply will result in the ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- ☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.
- ☒ APPLICANT MUST MAKE THE DRAWING CHANGES INDICATED BELOW IN THE MANNER SET FORTH ON THE REVERSE SIDE OF THIS PAPER.
 - ☒ Drawing informalities are indicated on the NOTICE RE PATENT DRAWINGS, PTO-948, attached ~~hereto~~ to Paper No. 4. CORRECTION IS REQUIRED.
 - ☐ The proposed drawing correction filed on _____ has been approved by the examiner. CORRECTION IS REQUIRED.
 - ☐ Approved drawing corrections are described by the examiner in the attached EXAMINER'S AMENDMENT. CORRECTION IS REQUIRED.
 - ☒ Formal drawings are now REQUIRED.

Any response to this letter should include in the upper right hand corner, the following information from the NOTICE OF ALLOWANCE AND ISSUE FEE DUE: ISSUE BATCH NUMBER, DATE OF THE NOTICE OF ALLOWANCE, AND SERIAL NUMBER.

Attachments:

- Examiner's Amendment
- Examiner Interview Summary Record, PTOL-413
- Reasons for Allowance
- Notice of References Cited, PTO-892
- Information Disclosure Citation, PTO-1449
- Notice of Informal Application, PTO-152
- Notice re Patent Drawings, PTO-948
- Listing of Bonded Draftsmen
- Other

Art Unit: 1649

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1649.

The following is an examiner's statement of reasons for allowance:

The application is allowed in view of Appellants' amendment of 19 August 1999 which was duplicative of the draft proposals faxed by the Examiner to Appellants for discussion in the interview of 30 July 1999. The amendments were in response to the Remand of 27 July 1999 as discussed below. The amendment of 19 August 1999 has been considered as an amendment under 37 CFR 1.116 since the application had not been allowed at the time of the amendment.

In the Remand of 27 July 1999, the Board of Patent Appeals queried what was encompassed by the claims, wherein such a determination was required before the merits of an art rejection could be considered. The Examiner has reviewed pages 8-9 of the specification cited by the Board. On pages 8-9, Appellants set forth four different promoter constructs: a 196bp TATA-only construct, a quarter length construct, a half length construct, and a full length construct. On pages 19 and 21 of the specification, Tables 1 and 2 respectively, it is demonstrated that the TATA-only construct does not cause gene expression.

On pages 8-9 of the Brief of 25 November 1994, Appellants urge that the prior art failed to teach or suggest the figwort mosaic virus 34S gene, let alone the corresponding promoter or its isolation and ligation to a heterologous structural gene for use in plant transformation. Appellants further urge that several TATA regions were present throughout the figwort mosaic virus genome

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(page 9 of the Brief), and that the prior art actually taught away from Appellants' particular gene and associated promoter (paragraph bridging pages 9 and 10 of the Brief), which had unexpectedly strong expression and was thus desirable for use in plant transformation.

Claim 20 and its dependents have been amended to reflect Appellants' successful results and to exclude Appellants' inoperative embodiment. See In re Lindner, 173 USPQ 356 (CCPA 1972) and In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983) which teach that the evidence of nonobviousness should be commensurate with the scope of the claims.

In the Remand of 27 July 1999, the Board further queries whether the claims meet the criteria of 35 USC 112, first paragraph, regarding an adequate written description. The Examiner maintains that the claims are drawn to a promoter region from a single viral species and a single gene within that virus, and that Appellants have also performed several deletions of the promoter and obtained promoter activity. Thus, the claims as amended are adequately supported by the specification. Note that the fact pattern in the instant application is different from that of *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997), which involved a disclosure drawn to DNA obtained from an organism of a particular genus and species and claims drawn to DNA obtained from an organism from a different genus and species.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Application/Control Number: 07/985,742

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 20, 1999

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1649

David T. Fox